

**REMARKS**

Claims 6-12 are pending in the present application. Claims 1-5 and 13 have been canceled without prejudice and without acquiescence. Claims 6, 8 and 12 have been amended without prejudice and without acquiescence. Support for the amendments can be found specifically on page 3, lines 30-31, and page 4, lines 1-6. Applicants retain the right to file a continuation and/or a divisional application to any canceled claims. No new matter has been added.

The issues outstanding in this application are as follows:

- Claims 4 and 5 were rejected under 37 CFR 1.75 (c) as being improper dependent form for failing to further limit the subject matter of a pervious claim.
- Claims 1, 2, 4-8, 10, 12 and 13 were rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Litborn et al. (WO 98/33052).
- Claims 1-5 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Mian et al. (US 6,319,469).
- Claims 1-5 were rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Kennedy et al. (US 6,488,895).
- Claims 9 and 11 were rejected under 35 U.S.C. § 103(a) as being allegedly upatentable by Litborn et al. (WO 98/33052) in view of Mian et al. (US 6,319,469).

Applicants respectfully traverse the outstanding rejections, and Applicants respectfully request reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

## I. Rejection under 37 CFR 1.75 (c)

Claims 4 and 5 are rejected under 37 CFR 1.75 (c) as being improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully traverse.

In order to further the prosecution of this application, Applicants have canceled claims 4 and 5 without acquiescence and without prejudice. Thus, this rejection is moot and Applicants respectfully request withdrawal of the rejection.

## II. Rejection under 35 U.S.C. § 102(a)

Claims 1, 2, 4-8, 10, 12 and 13 are rejected under 35 U.S.C. § 102(a) as being allegedly anticipated by Litborn et al. (WO 98/33052). Applicants respectfully traverse.

Anticipation of a claim is only established where “each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

In order to further the prosecution of this application, Applicants have canceled claims 1, 2, 4, 5 and 13 and amended independent claims 6 and 8 without acquiescence and without prejudice. Independent claims 6 and 8 have been amended to illustrate that the microvolume of solvent in the microarea of the present invention comprises reactants, which includes analytes and reagents. Thus, the present invention is drawn to the continuous addition of solvent to a microvolume on a microarea, wherein the microvolume comprises a sample and one or more reactants. Litborn et al. does not teach the addition of reactants to the solvent in combination with continuously adding solvent to the microarea to prevent desiccation of the sample. If anything, Litborn et al. teaches away from this technique. See page 4, lines 6-17 of Litborn et al.

More specifically, Litborn et al. teaches the use of a covering liquid to prevent evaporation. For example, page 17 of Litborn et al. teaches that myoglobin in a water-based buffer solution was added to the vials. The water was allowed to evaporate and octane (covering liquid) was added. Trypsin (reagent) dissolved in water was then added to the

dried myoglobin. Myoglobin will dissolve exclusively in the water phase in which the reaction with trypsin also will start (degradation). Due to the presence of the covering liquid there will be no evaporation of water (solvent) from the underlying water phase. Since octane (inert component containing no reactants) has a high vapor pressure it will evaporate during the reaction and therefore has to be replenished from an octane reservoir because otherwise desiccation of the myoglobin/trypsin sample will start as soon as all octane has disappeared. Thus, Litborn et al. does not teach replenishment of solvent that evaporates from a sample containing solvent and reactants. Litborn et al. teaches preventing desiccation of aqueous samples in a way that is completely different from the present invention. In light of the amendment and the arguments, Applicants request that the rejection be withdrawn.

### III. Rejection under 35 U.S.C. § 102(e)

#### A. Mian et al. (6,319,469)

Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Mian et al. (US 6,319,469). Applicants respectfully traverse.

In order to further the prosecution of this application, Applicants have canceled claims 1-5 without acquiescence and without prejudice. Thus, this rejection is moot and Applicants respectfully request withdrawal of the rejection.

#### B. Kennedy (6,488,895)

Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Kennedy et al. (US 6,488,895). Applicants respectfully traverse.

In order to further the prosecution of this application, Applicants have canceled claims 1-5 without acquiescence and without prejudice. Thus, this rejection is moot and Applicants respectfully request withdrawal of the rejection.

### IV. Rejection under 35 U.S.C. § 103(a)

Claims 9 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Litborn et al. (WO 98/33052) in view of Mian et al. (6,319,469). Applicants respectfully traverse.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

The present invention is drawn to the continuous addition of solvent to a microvolume on a microarea, wherein the microvolume comprises a sample and one or more reactants as illustrated in independent claim 8. Litborn et al. does not teach incorporating reactants in a liquid sample in combination with continuously adding solvent to the microarea to prevent desiccation of the sample. If anything, Litborn et al. teaches away from this technique. See page 4, lines 6-17. Applicants remind the Examiner that a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.* 796 F.2d 443, 230 USPQ 416 (Fed. Cir. 1986).

Since claims 9 and 11 are dependent from claim 8 and incorporate all the limitations of independent claim 8, claims 9 and 11 are nonobvious. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Thus, Applicants respectfully request that the rejection be withdrawn.

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In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. 10102583 from which the undersigned is authorized to draw.

Dated: January 26, 2004

Respectfully submitted,

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